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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,307	06/23/2000	Allen B. Childress	5053-27600	1776

7590

04/21/2003

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/603,307

Applicant(s)

CHILDRRESS ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 60-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9 and 10</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed February 06, 2003. Claims 1-59 have been canceled without prejudice. Claims 60-108 have been added. Claims 60-108 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 60-77, 80-93, 99, 101-105, and 107-108 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two –prong test of :

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve use, or advance the technological arts to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at claim 60 as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

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Examiner notes that the common usage of terms such as "a computer readable-medium" or a "computer system" are well taken to be within the statutory categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 60-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (5,950,169) in view of Abbruzzese et al (5,557,515).

(A) As per claim 60, discloses a method for processing an insurance claim to estimate a value of the insurance claim (Col.1, lines 24-55), the method comprising:

displaying a first insurance claim processing step (Col.3, lines 13-23);

receiving input regarding the first insurance claim processing step (Col.2, lines 60-67 to Col.3, line 30);

determining a table of contents based at least on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49);

determining a table of contents based at least on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49);

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displaying a table of contents, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67). Borghesi does not explicitly disclose selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step.

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step (Col.17, lines 22-67 to Col.18, line 67; Col.19, lines 1-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Abbruzzese within the system of Borghesi with the motivation of providing a claim office supervisors and other staff members with the ability to maintain an accurate record to all activities undertaken in the processing of a claim and the further ability to quickly and easily access the complete claim file (See Abbruzzese, Col.3, lines 12-17).

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(B) As per claim 61, Borghesi discloses the method wherein displaying the second insurance claim processing step comprises displaying a report, wherein the report comprises a value of the insurance claim, and wherein the report is determined based on information input in the first insurance claim processing step and on any insurance claim processing steps in between the first insurance claim processing step and the second insurance claim processing step (Col.5, lines 19-50).

(C) As per claim 62, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step (The Examiner interprets refresh the display as a form of redisplay Col.5, lines 51-67 to Col.6, lines 15-45).

(D) As per claim 63, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step; and receiving input regarding the first insurance claim processing step after redisplaying the first insurance claim processing step (Col.5, lines 51-67 to Col.6, line 45).

(E) As per claim 64, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step (Col.5, lines 51-67 to Col.6, line 45); receiving input regarding the first insurance claim processing step after redisplaying the first insurance claim processing

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step (Col.5, lines 51-67 to Col.6, line 45); and determining the table of contents again based at least in part on input received regarding the first insurance claim processing step and input received regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49).

(F) As per claim 65, Borghesi discloses the method wherein the insurance claim comprises a bodily injury claim, and wherein processing the insurance claim to estimate the value of the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value (Col.5, lines 1-36).

(G) As per claim 66, Borghesi discloses the method further comprising: receiving input regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49); and determining the table of contents again based at least in part on input received regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49).

(H) As per claim 67, Abbruzzese discloses the method wherein the table of contents comprises an ordered list of insurance claim processing steps (Col.19, lines 18-67).

(I) As per claim 68, Borghesi discloses the method wherein insurance claim processing steps comprise steps for entry of information relevant to the estimate of the value of the insurance claim (Col.5, lines 1-50).

(J) As per claim 69, Abbruzzese discloses the method wherein the information relevant to the estimate of the value of the insurance claim comprises bodily injury treatment information (Col.27, lines 1-67).

(K) As per claim 70, Abbruzzese discloses the method wherein the information relevant to the estimate of the value of the insurance claim comprises bodily injury damages information (Col.30, lines 17-67).

(L) As per claim 71, Abbruzzese discloses the method wherein the table of contents further comprises pointers to display screens associated with the insurance claim processing steps (Col.30, lines 17-67 to Col.31, line 67).

(M) As per claim 72, Borghesi discloses the method further comprising: storing information input at one or more insurance claim processing steps (Col.6, lines 1-44).

(N) As per claim 73, Abbruzzese discloses the method wherein insurance claim processing steps are associated with display in table of contents properties (Col.39, lines 25-67 to Col.40, line 47), and wherein determining the table of contents comprises determining insurance claim processing steps associated with display in table of contents properties which indicate that the insurance claim processing steps should be included in the table of contents (Col.39, lines 25-67 to Col.40, line 47).



(O) As per claim 74, Abbruzzese discloses the method wherein insurance claim processing steps are associated with display in table of contents properties, wherein determining the table of contents comprises determining insurance claim processing steps associated with display in table of contents properties which indicate that the insurance claim processing steps should be included in the table of contents, and wherein at least on display in table of contents properties comprises a condition which specifies when an associated insurance claim processing step should be included in the table of contents (Col.39, lines 25-67 to Col.40, line 47).

(P) As per claim 75, Borghesi discloses a method of processing an insurance claim using an insurance claim processing system, wherein the insurance claim processing system (Col.20, lines 34-50), the method comprising: receiving a request to estimate an insurance claim (Col.5, lines 1-67), wherein the request comprises a claim identifier associated with the insurance claim (Col.6, lines 33-67); selecting at least one step associated with the insurance claim (Col.5, lines 1-36); if the selected step is not the end step then: providing a display associated with the selected step (Col.11, lines 53-67 to Col.12, line 35); receiving input associated with the selected step (Col.5, lines 6-67); storing the input received (Col.5, lines 51-67 to Col.6, line 51); and if the selected step is the end step then: providing a display comprising an estimated value of the insurance claim (Col.5, lines 27-67 to Col.6, line 32). Borghesi does not explicitly disclose determining a display of table of contents associated with the claim identifier,

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wherein the table of contents display represents one or more steps for processing the insurance claim, and wherein at least one step comprises an end step.

However, this feature is known in the art, as evidenced by Abbruzzese .In particular, Abbruzzese suggests a display of table of contents to the client system associated with said claim identifier, wherein the table of contents display represents one or more steps associated with said insurance claim, wherein one of the one or more steps comprises an end step (See Abbruzzese Col.17, lines 22-67 to Col.18, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Abbruzzese within the system of Borghesi with the motivation of providing a claim office supervisors and other staff members with the ability to maintain an accurate record of all activities undertaken in the processing of a claim and the further ability to quickly and easily access the complete claim file (See Abbruzzese Col.3, lines 12-17).

(Q) As per claim 76, Borghesi discloses the method wherein the one or more steps for processing the insurance claim are dynamically modifiable in response to received input (Col.5, lines 27-67).

(R) As per claim 77, Borghesi discloses the method further comprising adding or deleting one or more steps from the table of contents display in response to received input (Col.8, lines 15-64).

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(S) Claim 78 differs from claims 60 and 75 by reciting a method for dynamically creating a table of contents display screen.

As per this limitation, it is noted that Borghesi discloses wherein the table of contents display screen is associated with a specified insurance claim (Col.8, lines 3-67), determining whether a previous display screen pointer is associated with a display screen of a set of one or more display screens associated with a specified insurance claim (Col.7, lines 40-53); if a previous display screen pointer is not associated with the display screen, adding the display screen to said table of contents display screen (Col.7, lines 40-53); if a previous display screen pointer is associated with the display screen, determining whether a source of data property associated with the display screen indicates that data associated with the display screen is input received from a user (Col.4, lines (Col.7, lines 40-67); if the source of data property associated with the display screen indicates that data associated with the display screen is input received from a user (Col.4, lines 40-67) and Abbruzzese discloses adding the display screen to the table of contents display screen; and storing said table of contents display screen.

Thus, it is readily apparent that these prior art systems utilize a table of contents display screen to perform their specified function.

The remainder of claim 78 is rejected for the same reason given above for claims 60 and 75, and incorporated herein.

(T) As per claim 79, Borghesi discloses a system for processing an insurance claim to estimate a value of the insurance claim (Col.1, lines 24-55), the system comprising: a

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CPU (Col.7, lines 10-28); a display coupled to the CPU (Col.6, lines 6-14); a memory coupled to the CPU, wherein the memory stores program instructions which are executable by the CPU (Col.6, lines 6-14) to:

display a first insurance claim processing step (Col.6, lines 1-45); receive input regarding the first insurance claim processing step (Col.5, lines 16-67); determine a table of contents based at least in part on input received regarding the first insurance claim processing step; display a table of contents, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67). Borghesi does not explicitly disclose select a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and display the second insurance claim processing step.

However, these features are known in the art, as evidenced by Abbuzzese. In particular, Abbruzzese suggests select a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and display the second insurance claim processing step (See Abbruzzese, Col.16, lines 23-67 to Col.17, lines 1-67; Col.18, lines 1-67).

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(U) Claims 80-93 and 95-108 recite the underlying process steps of the elements of claims 61-74 respectively. As the various elements of claims 61-74 have been shown to be either disclosed by or obvious in view of the collective teachings of Borghesi and Abbruzzese, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 80-93 and 95-108 are rejected for the same reasons given above for method claims 61-74, and incorporated herein.

(V) Claim 94 differs from claims 60, 75, 78-79 by reciting a carrier medium comprising program instructions for processing an insurance claim to estimate a value of the insurance claim, wherein the program instructions are computer-executable to implement.

As per this limitation, it is noted that Borghesi discloses displaying a first insurance claim processing step (Col.3, lines 13-23); receiving input regarding the first insurance claim processing step (Col.2, lines 60-67 to Col.3, line 30);

determining a table of contents based at least in part on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49); displaying a table of contents, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67; Col.10, lines 29-67 to Col.11, line 18) and Abbruzzese discloses selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the

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additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step.

Thus, it is readily apparent that these prior art systems utilize program instructions to perform their specified function.

The remainder of claim 94 is rejected for the same reason given above for claims 60, 75, 78-79, and incorporated herein.

### ***Response to Arguments***

6. Applicant's arguments filed 02/06/03 with respect to claims 60-108 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 02/06/03.

(A) At page 14, Applicant's argues that Borghesi does not appear to explicitly disclose displaying a table of contents. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner suggests that Abbruzzese discloses "a table of contents enabling an operator to select a desired system function or transaction" which is corresponding to the claimed feature (See, Abbruzzese, Col.17, lines 1-67). Therefore, Applicant's argument is not persuasive.

(B) At page 15, Applicant's argues that Abbruzzese does not appear to teach or suggest determining a table of contents display based on input received in an insurance claim processing step. However, the Examiner disagrees.

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In response to Applicant's arguments, Examiner suggests that Abbruzzese discloses "The processing of a claim begins upon receipt of a notice of loss. These "Losses Notices" are received from agents, insured, customers or claimants, either through the mail, in person, electronically or over the telephone". In a typical claims office, a person called a Claim Assistant is primarily responsible for the input of Loss Notices into the System. The Loss information is input through a Loss Processing Transaction ("LPTX") function which may be accessed from a Primary Menu (see, e.g., Tables I and II) or by placing the four letter code "LPTX" in the "Next Trans" field of any transaction which is corresponding to the claimed feature (See Abbruzzese, Col.17, lines 59-67 to Col.18, line 67). Therefore, Applicant's argument is not persuasive.

(C) At page 18-19, Applicant's argues that Borghesi do not appear to teach or suggest the use of pointers and adding display screens to a table of contents. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner suggests that Abbruzzese discloses " A set of LP-Element Change screens are used to add, modify or delete information previously input via the LPTX. An LP-Element changes screen (not shown) is accessed via a Main Menu selection or by entering "ECHG" in any "Next Trans" field. Each LP-Element Change transaction is comprised of prefilled screens containing essentially the same fields as the corresponding original LPTX screens. Changes are made on a per-screen basis. In other words, information entered via an LPT is

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redisplayed screen-by-screen for correction of any item on that screen (See, e.g., Table XVI.)

There are two ways to change element information previously input via the LPTX.

1. Overlay

The cursor is moved to the desired field location on the display and the original information in that field is typed over. This continues through each succeeding field requiring modification. If the modified information has fewer characters than before, any extra characters may be deleted by erasing to the end of the field" which is corresponding to the claimed feature (See Abbruzzese, Col.30, lines 65-67 to Col.31, line 48; Col.129, lines 53-67 to Col.130, line 19). Therefore, Applicant's argument is not persuasive.

Further, Applicant's argues that Borghesi does not appear to teach or suggest adding display screens to a table of contents. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner suggests that Abbruzzese discloses " additional screens are available within the Staff Tables to modify staff member information and to delete staff member from the file" which is corresponding to the claimed feature (See Abbruzzese, Col.37, lines 1-42). Therefore, Applicant's argument is not persuasive.

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a system for web-based payroll and benefits administration (6,401,079), insurance claims estimate, text, and graphics network and method (5,504,674).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F

April 18, 2003



DINH X. NGUYEN  
PRIMARY EXAMINER